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10/733,058	12/11/2003	Hikaru Kobayashi	075834.00460	7840
33448	7590	12/04/2007		
ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			EXAMINER MARINI, MATTHEW G	
			ART UNIT 2854	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/733,058

Applicant(s)

KOBAYASHI ET AL.

Examiner

Matthew G. Marini

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 17-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 17 and 21 do not require the structure of the adhesive labels being in the form of a roll as seen in independent claims 6, 7 and 11, and therefor are restricted based on original presentation, due to the fact that the medium could be in the form of sheets requiring a completely different and separate apparatus to perform the method steps. Also, claims 17 and 21 require an uncut medium comprising several different layers, where the medium is cut by a cutting step. However, independent claims 6, 7, and 11 recited a medium which has already been cut, not actually reciting any cutting means. Therefore, claims 17 and 21 are also restrictable based on the fact that claims 17 and 21 require cutting means to perform the cutting steps, therefore requiring a completely separate and different apparatus as to what is being claimed in the independent claims 6, 7, and 11.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-24 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins (4,457,981).

As to Claim 6, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, comprising a printing surface, 35, on which one or more images, 38, are to be printed; a printing layer, 35, that is releasably adhered via adhesive, 31, to a release layer, 30, the release layer, 30, for holding said printing layer, 35, wherein a first longitudinal portion, 44, of said printing medium, 30 and 35, has said printing layer, 35, that has been at least cut along a conveying direction, arrow located near element, 31', of the printing medium, 30 and 35, at an interval corresponding to the dimension (size) of the images, 38, in a width direction, as seen in Fig. 3, perpendicular to the conveying direction, arrow described above, and wherein said roll, R, has a second portion, where image, 38, is located (between cuts 44), wherein the printing layer is not cut along a conveying direction along the conveying direction, arrow, of the printing medium, 30 and 35, and wherein neither the first portion, where cuts, 44, occur, nor the second portion, where images, 38 are printed contain width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, 30 and 35.

As to Claim 7, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 31 and 36, comprising: a printing surface, 35, on which one or more images, 38, are to be printed; a printing layer, 35, that is releasably adhered to a release layer, 30, via adhesive, 31, the release layer, 35, for holding the printing layer,

35, wherein the layers, 30 and 35, comprising the medium, R, are rolled in a spiral shape to form a roll-shaped printing medium, seen at Fig. 3, R and wherein an image forming portion, 35, of said printing medium, 30 and 35, has said printing layer, 35, that has been at least partially cut, 44, via cutters, 42, along a conveying direction, arrow seen near element, 31', of the image printing medium, 30 and 35, at an interval corresponding to the dimension of said images, 38, in a width direction perpendicular to said conveying direction as seen in Fig. 3, and wherein the image-forming portion, 35, of said roll, R, has said printing layer, 35, that is not cut at all in a width direction perpendicular to the conveying direction, arrow seen near element, 31'.

As to Claim 8, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 36 and 31, wherein said image forming portion, 35, extends substantially the entire longitudinal length of said print medium, 30 and 35.

As to Claim 9 Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 36 and 31, wherein there are at least three cuts, 44, made, seen at cutter, 42, in the longitudinal direction of said printing layer, 35, and wherein each cut, 44, is spaced apart at a pre-determined distance in a direction perpendicular to the conveying direction, arrow as described above, of the print medium, 30 and 35 to allow image, 38, to be between two cuts, 44.

As to Claim 10, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 36 and 31, wherein there are at least three cuts, 44, made, seen at cutter, 42, in the longitudinal direction of said printing layer, 35, and wherein the cut, 44, is spaced apart at a pre-determined distance in a direction perpendicular to the

conveying direction, arrow as described above, of the print medium, 30 and 35 to allow image, 38, to be between two cuts, 44.

As to Claim 11, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a printer, rollers, 31 and 36, comprising: a printing surface, 35, on which on or more images, 38, are to be printed; a printing layer, 35, that is releasably adhered to a release layer, 30, via adhesive, 31, the release layer, 35, for holding the printing layer, 35, wherein an image-forming portion, 35, of the said printing medium, 30 and 35, has a printing layer, 35, that has been at least partially cut, 44, via cutters, 42, along a conveying direction, arrow seen near element, 31', of the image printing medium, 30 and 35, at an interval corresponding to the dimension of said images, 38, in a width direction perpendicular to said conveying direction as seen in Fig. 3, and wherein the image-forming portion, 35, of said roll, R, has said printing layer, 35, that is not cut at all in a width direction perpendicular to the conveying direction, arrow seen near element, 31'.

As to Claim 12, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 36 and 31, wherein said image forming portion, 35, extends substantially the entire longitudinal length of said print medium, 30 and 35.

As to Claim 13, Jenkins teaches in Fig. 3 a roll-shaped printing medium, R, for use in a roll printer, 36 and 31, wherein there are at least three cuts, 44, made, seen at cutter, 42, in the longitudinal direction of said printing layer, 35, and wherein each cut, 44, is spaced apart at a pre-determined distance in a direction perpendicular to the

conveying direction, arrow as described above, of the print medium, 30 and 35 to allow image, 38, to be between two cuts, 44.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins (4,457,981) in view of Campbell, Jr (4,747,782).

As to Claims 14-16 Jenkins teaches all that is claimed in the above rejection of claims 6, 7, and 11, except the printing layer that has only been partially cut. However, Campbell, Jr teaches in Fig. 1 and 4, a printing system where a printing layer is partially cut. It would have been obvious to one of ordinary skill in the art at the time of invention to replace the full cutting means, slitters, 42, of Jenkins with the half-cutting means, 60, of Campbell, Jr. because it causes the print layer portion to be pulled off with a higher amount of force than a fully cut portion, ensuring that the upper print surface does not fall off during secondary operations causing jams.

***Response to Arguments***

Applicant's arguments filed 10/1/07 have been fully considered but they are not persuasive. In response to applicant's arguments, specifically how Jenkins does not teach the first portion nor the second portion from containing width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, the examiner

respectfully disagrees. Insofar a recited structure defining the portions of the printing medium, the first portion, 44, reads on the portion of the print medium where the cuts, 44, happen to reside in the conveying direction of the medium. But at the same portion, 44, there are no cut which are in the direction perpendicular to the conveying direction. Only in layer, 30, do cuts made by roller, 39, exist in the direction perpendicular to the conveying direction. These cuts made by roller, 39, do not penetrate the print layer, Col. 3 lines 54-58, but only the bottom layer, 30. The same can be said about the second portion define by where the image, 38, resides. At the second portion, 38, there does not exist cuts in the direction perpendicular to the conveying direction, only in the bottom layer, 30.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Marini whose telephone number is (571)-272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571)-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Marini



12/3/07



**REN YAN**  
**PRIMARY EXAMINER**